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In re Application of	:	
HALLENBECK et al.	:	
Application No.: 10/553,459	:	DECISION
PCT No.: PCT/US2004/011622	:	
Int. Filing Date: 15 April 2004	:	
Priority Date: 15 April 2003	:	
Attorney Docket No.: 3802-165-27 NATL	:	
For: FLAP ENDONUCLEASE 1 (FEN1)	:	
REGULATORY SEQUENCES AND USES THEREOF	:	

This is a decision on applicants' submission filed 17 November 2006, which has been properly treated as a petition under 37 CFR 1.47(a), in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** without prejudice.

**BACKGROUND**

On 15 April 2004, applicants filed international application PCT/US2004/011622, which designated the United States and claimed a priority date of 15 April 2003. A copy of the international application was communicated from the International Bureau to the USPTO on 28 October 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 17 October 2005 (15 October 2005 being a Saturday).

On 17 October 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 19 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage were required.

On 17 November 2006, applicants filed a submission which was accompanied by, *inter alia*, a declaration of inventors, the surcharge under 37 CFR 1.492(h), a declaration of facts by Jessica N. Cecena, a copy of an e-mail from Jessica Cecena to non-signing inventor Garret

Hampton dated 02 November 2006, and a copy of a letter from Jessica Cecena to non-signing inventor Garret Hampton dated 22 September 2006. The submission has been properly treated as a petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to item (1), the petition fee of \$200 has been charged to Deposit Account 07-1896.

Items (3) has been met.

Item (2) has not been met. It is not clear whether it is being alleged that Garret Hampton refuses to execute the application or that he cannot be reached after diligent effort. The two are distinct. *See, e.g.*, MPEP 409.03(d), item I. "Inventor Cannot Be Reached" and item II. "Refusal to Join." A first e-mail was sent to Mr. Hampton on 19 October 2006. A second e-mail was sent to him on 02 November 2006. It is not clear if either of these e-mails were received by Mr. Hampton. Accordingly, it is not clear if Mr. Hampton received the e-mails and did not respond or if he did not receive them. A letter was sent to Mr. Hampton's last known address on 22 September 2006. Again, it is not clear if Mr. Hampton received the letter and did not respond or if he no longer resides at that address.

If it is being alleged that Mr. Hampton refuses to sign, the inventor must be presented with a complete copy of the application papers (specification, including claims, drawing, and oath or declaration) for a refusal to be established. Thus, if Mr. Hampton's address is found, a complete copy of the application papers would still need to be presented to him. It does not appear that a copy of the specification was ever sent to Mr. Hampton.

If it is being alleged that Mr. Hampton cannot be reached or found, a bona fide attempt to find his address must be made and copies of documentary evidence such as *internet searches*, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the non-signing inventor could not be found or reached should be made part of the affidavit or declaration. See MPEP § 409.03, item I.

Item (4) has not been met. The declaration of inventors filed 17 November 2006 is not in compliance with 37 CFR 1.497(a)-(b). The declaration includes three page threes. Each declaration must be complete in and of itself. I.e., each declaration must identify, *inter alia*, each inventor. It is not clear from the declaration filed 17 November 2006 that each declaration presented to and signed by the inventors was complete. It appears that five inventors signed five

separate declarations. However, only one declaration, which contains three page threes was provided. Applicants must submit either a single declaration executed by all of the inventors, with the exception of any non-signing inventors, or in the alternative a copy of the entire declaration for each signed declaration.

**CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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